

REMARKS

The Office Action dated June 28, 2006, has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claims 1-18 are currently pending in the application, of which claims 1, 11, and 17-18 are independent. Claims 1-18 have been amended to more particularly point out and distinctly claim the invention. No new matter has been added. Claims 1-18 are respectfully submitted for consideration.

Claims 1-7 and 11-18 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application No. 2003/0217142 of Bobde et al. ("Bobde") in view of U.S. Patent No. 6,885,861 of Koskelainen ("Koskelainen"). Applicants respectfully traverse this rejection, because Koskelainen is not proper art to show obviousness.

Koskelainen is a Nokia Corporation patent that was issued after the effective filing date of the present application. As such, 35 U.S.C. 103(c) bars the USPTO from relying on Koskelainen to show that the claims of the present application are obvious. Koskelainen issued April 26, 2005, based on an application filed August 24, 2001. The present application was filed January 4, 2005, and claims priority to Jun 14, 2002. Thus, Koskelainen is prior art, if at all, only under 35 U.S.C. 102(e).

Moreover, Koskelainen and the present application were subject to an obligation of assignment to the same entity, Nokia Corporation, at the time of the invention. The assignment of Koskelainen to Nokia Corporation was recorded on October 25, 2001, at

Reel 012288, Frame 0977. The present application's assignment to Nokia Corporation was recorded on January 4, 2005, at Reel 016444, Frame 0472. This assignment evidences the obligation of assignment to the same entity, namely Nokia Corporation.

Because Koskelainen and the present application were subject to an obligation of assignment to the same entity at the time of the invention, and because Koskelainen is available as prior art, if at all, only under 35 U.S.C. 102(e), 35 U.S.C. 103(c) specifically prohibits the USPTO from citing Koskelainen to establish obviousness of the claimed invention. The rejection cannot survive without Koskelainen because, as the Office Action acknowledges, Bobde fails to disclose or suggest all of the elements of any of the presently pending claims. Accordingly, Applicants respectfully request that the rejection of claims 1-7 and 11-18 be withdrawn on the basis that Koskelainen is not proper prior art as used.

Claims 8-9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bobde and Koskelainen and further in view of "IMPS – Instant Messaging and Presence Using SIP" of Donovan ("Donovan"). Applicants respectfully traverse this rejection.

As noted above, Koskelainen is not proper prior art to show obviousness of the claims of the present application. The rejection cannot survive without Koskelainen. It is, therefore, respectfully requested that the rejection of claims 8-9 be withdrawn.

Claim 10 was rejected under 35 U.S.C. 103(a) as being unpatentable over Bobde, Koskelainen, and Donovan and further in view of U.S. Patent Application No. 2003/0105864 of Mulligan et al. ("Mulligan"). Applicants respectfully traverse this

rejection, because neither Koskelainen nor Mulligan is proper prior art to show obviousness. Koskelainen is discussed above.

Mulligan is a Nokia Corporation patent application that was published after the effective filing date of the present application. As such, 35 U.S.C. 103(c) bars the USPTO from relying on Mulligan to show that the claims of the present application are obvious.

Mulligan was published June 5, 2003, based on an application filed January 11, 2002. Mulligan is a continuation-in-part application of U.S. Application No. 09/996,406, which was filed November 20, 2001. The present application was filed January 4, 2005, and claims priority to Jun 14, 2002. Thus, Mulligan is prior art, if at all, only under 35 U.S.C. 102(e).

Moreover, Mulligan and the present application were subject to an obligation of assignment to the same entity, Nokia Corporation, at the time of the invention. The assignment of Mulligan to Nokia Corporation was recorded on June 11, 2002, at Reel 012975, Frame 0938. The present application's assignment to Nokia Corporation was recorded on January 4, 2005, at Reel 016444, Frame 0472. This assignment evidences the obligation of assignment to the same entity, namely Nokia Corporation.

Because Mulligan and the present application were subject to an obligation of assignment to the same entity at the time of the invention, and because Mulligan is available as prior art, if at all, only under 35 U.S.C. 102(e), 35 U.S.C. 103(c) specifically

prohibits the USPTO from citing Mulligan to establish obviousness of the claimed invention.

As explained above, Koskelainen is also not proper prior art to show obviousness of the claims of the present application. The rejection cannot survive without either Koskelainen or Mulligan. Accordingly, Applicants respectfully request that the rejection of claim 10 be withdrawn on the basis that Koskelainen and Mulligan are not proper prior art as used.

For the reasons above, it is respectfully submitted that each of claims 1-18 recites subject matter that is neither disclosed nor suggested in the prior art. It is, therefore, respectfully requested that all of claims 1-18 be allowed, and that this application be passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,


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